

## **REMARKS**

By this Amendment, Applicants amend claims 1, 17, and 33. Claims 1-34 are pending in this application. In the Office Action identified above, the Examiner rejected claims 1-4, 17-20, and 33-34 under 35 U.S.C. § 102(b) as being anticipated by Murray (U.S. Patent No. 5,699,089); rejected claims 5-8 and 21-24 under 35 U.S.C. § 102(e) as being anticipated by Moon et al. (U.S. Patent No. 6,629,000); and rejected claims 9-16 and 25-32 under 35 U.S.C. § 103(a) as being unpatentable over Burrows (U.S. Patent No. 6,377,530).

### **I. Information Disclosure Statement**

As an initial matter, Applicants respectfully request the Examiner to provide an initialed copy of the Information Disclosure Statement filed on October 10, 2000, since it was not included with the Office Action identified above.

### **II. The Rejection of Claims 1-4, 17-20, and 33-34 Under 35 U.S.C. § 102**

Claims 1-4, 17-20, and 33-34 were rejected under 35 U.S.C. § 102(b) as being anticipated by Murray. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Murray fails to teach each and every recitation of claim 1.

Claim 1 recites “[a] recording and reproducing apparatus,” including *inter alia*, “means for requesting content from an external device.” Murray fails to disclose or teach at least this limitation. Murray discloses a computer-based system for controlling sequential playback objects (“SPOs”). (See Abstract.) To this end, Murray discloses

the use of the same tool bar to control SPOs which have different characteristics. (See FIG. 4 and Col. 3, lines 25-37.) Murray also teaches the processing after a selection of a record indicator by the user in FIG. 6G. However, Murray does not teach or suggest at least “means for requesting content from an external device,” as recited in claim 1. That is, Murray fails to teach the recording and reporting apparatus “requesting content from an external device,” as recited in claim 1. Murray, as shown in FIG. 6G, teaches establishing a telephone connection. However, this teaching does not constitute “means for requesting content from an external device,” as recited in claim 1. Therefore, Applicants request the Examiner to withdraw the rejection of claim 1 and allow the claim.

Claims 2-4 depend from claim 1. As explained, claim 1 recites elements not disclosed by Murray. Accordingly, claims 2-4 are allowable over Murray for at least the same reasons as claim 1. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Claims 17 and 33, although of different scope, recite elements similar to that discussed above with regard to claim 1. Applicants therefore submit that claims 17 and 33 are also allowable over Murray.

Claim 34 depends from claim 33. As explained, claim 33 recites elements not disclosed by Murray. Accordingly, claim 34 is allowable over Murray for at least the same reasons as claim 33. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

**III. The Rejection of Claims 5-8 and 21-24 Under 35 U.S.C. § 102**

Claims 5-8 and 21-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Moon et al. Applicants respectfully traverse this rejection.

Claim 5 recites “[a] recording and reproducing apparatus,” including *inter alia*, “means for controlling said recording and said reproducing means in accordance with the operation mode set by said setting means when said determining means determines that the apparatus is connected to the external device.” Moon et al. fails to disclose or teach at least this limitation. Moon et al. discloses an MPEG portable sound reproducing system . (See Abstract.) The Examiner alleges that Moon et al. discloses setting an operation mode via an information selector, wherein the “information selector contains predetermined keys operated by the user, and outputs electrical signals according to the user selections to . . . extract data for reproduction, control various functions related to the reproducing of data and transmit and receive data.” (See OA at 5.) The Examiner alleges that these teachings of Moon et al. constitute the claimed “means for controlling said recording and said reproducing means in accordance with the operation mode set by said setting means when said determining means determines that the apparatus is connected to the external device,” as recited in claim 5. Applicants respectfully disagree.

Even assuming the Examiner’s allegations are true, which Applicants do not necessarily accept, it is respectfully submitted, that the Examiner has failed to show where Moon et al. teaches “means for controlling said recording means . . . in accordance with the operation mode set by said setting means,” as recited in claim 5. The Examiner alleges that Moon et al. discloses the “information selector contains

predetermined keys operated by the user, and outputs electrical signals according to the user selections to . . . extract data for reproduction, control various functions related to the reproducing of data and transmit and receive data.” That is, the Examiner has failed to show where Moon et al. teaches “means for controlling said recording means,” as recited in claim 5. Indeed, Moon et al. is silent as to “means for controlling said recording and said reproducing means in accordance with the operation mode set by said setting means when said determining means determines that the apparatus is connected to the external device,” as recited in claim 5. Therefore, Applicants request the Examiner to withdraw the rejection of claim 5 and allow the claim.

Claims 6-8 depend from claim 5. As explained, claim 5 recites elements not disclosed by Moon et al. Accordingly, claims 6-8 are allowable over Moon et al. for at least the same reasons as claim 5. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Claim 21, although of different scope, recites elements similar to that discussed above with regard to claim 5. Applicants therefore submit that claim 21 is also allowable over Moon et al.

Claims 22-24 depend from claim 21. As explained, claim 21 recites elements not disclosed by Moon et al. Accordingly, claims 22-24 are allowable over Moon et al. for at least the same reasons as claim 21. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

**IV. The Rejection of Claims 9-16 and 25-32 Under 35 U.S.C. § 103**

Applicants respectfully traverse the rejection of claims 9-16 and 25-32 under 35 U.S.C. § 103(a) as being unpatentable over Burrows because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8<sup>th</sup> Ed., Aug. 2001), quoting In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8<sup>th</sup> Ed. 2001), pp. 2100-122 to 127.

Claim 9 recites "[a] recording and reproducing apparatus," including *inter alia*, "means for detecting that a sufficient amount of the content is buffered when a recording command is issued during reproduction" and "means for enabling said recording means when said detecting means detects that the sufficient amount of the content is buffered." The Examiner admits that Burrows does not teach "a recording command or means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered." (See OA at 7.) To compensate for this shortcoming, the Examiner appears to take Official Notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made to "stop the

audio player when it is connected to the computer system via computer jack 131 in figure 1.” (See OA at 7.).

Applicants traverse the Examiner's taking of Official Notice that the above-noted recitations of claim 9 are obvious. An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that the recitations recited in claim 9 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Accordingly, Applicants traverse the Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

Further, Applicants remind the Examiner of the following provision set forth in M.P.E.P. § 2144.03:

[w]hen a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

To the extent the Examiner is relying on personal knowledge in taking Official Notice that the features of claim 9 are well known, Applicants request that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner's conclusions. Moreover, it is respectfully noted that the features that the Examiner states are obvious do not meet the limitations of claim 9 as claimed. Specifically, the Examiner states that "it would have been obvious to one of ordinary skill in the art to stop the audio player when it is connected to the computer system via computer jack 131 in figure 1." (See OA at 7.) It is respectfully submitted, that as presently claimed, claim 9 states "means for detecting that a sufficient amount of the content is buffered when a recording command is issued during reproduction" and "means for enabling said recording means when said detecting means detects that the sufficient amount of the content is buffered." It is respectfully noted that the features that the Examiner alleges to be obvious do not match the limitations of claim 9. That is, even if it is obvious "to stop the audio player when it is connected to the computer," the Examiner has failed to provide any evidence of a "means for detecting that a sufficient amount of the content is buffered when a recording command is issued during reproduction" and "means for enabling said recording means when said detecting means detects that the sufficient amount of the content is buffered," as recited in claim 9. Indeed, Burrows is silent as to at least these features of claim 9. Applicants therefore respectfully request that the rejection of this claim under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

Claim 25, although of different scope, recites elements similar to that discussed above with regard to claim 9. Applicants therefore submit that claim 25 is also allowable over Burrows.

Claims 10-16 and 26-32 depend from claims 9 and 25, respectively. As explained, claims 9 and 25 recite elements not disclosed by Burrows. Accordingly, claims 10-16 and 26-32 are allowable over Burrows for at least the same reasons as claims 9 and 25. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

**V. Conclusion**


Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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